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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/805,694	03/22/2004	Katsushi Horihata	P1348US	8737
1218	7590	08/22/2007	EXAMINER	
CASELLA & HESPOS 274 MADISON AVENUE NEW YORK, NY 10016			JOHNSON, GREGORY L	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,694

Applicant(s)

HORIHATA, KATSUSHI

Examiner

GREGORY JOHNSON

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>03/22/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This communication is in response to the application filed March 22, 2004.

Claims 1-9 have been examined.

Claim Objections

2. Claim 4 is objected to because of the following informalities:

"A wide area network printing system which is so configured as to allow users to print out print data sent from a server by an image forming apparatus..."

The limitation would read better with the following amendment:

"A wide area network printing system which is so configured as to allow users to print out print data sent from a server by using an image forming apparatus..."

Appropriate correction is required.

Claim 4 is also objected to because of the following informalities:

"the image forming apparatus includes:

- an accepting unit that accepts input of the document ID by the user;
- a transmitting unit that transmits the document ID inputted to the accepting unit;

The 3rd line could be interpreted to mean transmitting to the accepting unit.

The language could be amended to read:

"a transmitting unit that transmits said document ID to the server;"

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-9, the Examiner finds the use of the term "communications terminal" as being broad. See MPEP § 2173.05(d).

For examination purposes, the Examiner will use the references recited in the specification (page 7, para. 0022), specifically, a portable telephone, a personal computer (PC), or a personal digital assistant (PDA).

Appropriate correction is required.

Regarding claims 4 and 6-9, the Examiner finds the use of the term "image forming apparatus" as being broad. The term "image forming apparatus" is not defined by the claims, and the specification only recites "a printer incorporated in the image forming apparatus" (page 1, para. 0002).

For examination purposes, the Examiner will interpret "image forming apparatus" to mean a printer.

Appropriate correction is required.

Regarding claims 4 and 6-9, the Examiner finds the use of the term "various data" as being broad. The term "various data" is not defined by the claims or the specification.

For examination purposes, the Examiner will interpret "various data" in claim 4 to mean "print data" and "document ID". In claims 6-9, the Examiner finds that the term "various data" can be removed without effecting the limitations of the claims.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

7. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki, Pub. No. 2002/0041394 (hereinafter Aoki), in view of Rosen, Pat. No. 6,205, 436 (hereinafter Rosen) and Kawan, Pat. No. 6,442,532 (hereinafter Kawan).

Examiner's Note: The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant.

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Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

As to claims 1, 3 and 4, Aoki discloses the following limitations:

- an electronic transaction system provided with a communications terminal storing information relating to electronic money (para. 0010-0011 and 0240-0244)
- a wide area network printing system which is so configured as to allow users to print out print data sent from a server by an image forming apparatus which is installed remotely away from the server but is communicatively connected therewith via the Internet, the system provided with a communications terminal storing information relating to electronic money therein, and an accounting control device which allows the users to make settlement of a print fee corresponding to the print data by data communication with the communications terminal (para. 0007-0014 and 0142-0144),

the server includes:

- a data sending/receiving unit that communicates various data with the image forming apparatus (para. 0134);

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- a print data storing unit that stores the print data therein (content server para. 0134);
- a document ID storing unit that stores the document ID for identifying the print data stored in the print data storing unit (content server para. 0134); and
- a document ID transmitting unit that transmits the document ID stored in the document ID storing unit to the communications terminal of the user (content server para. 0134);

the image forming apparatus includes:

- an accepting unit that accepts input of the document ID by the user (para 0155-0157);
- a transmitting unit that transmits the document ID inputted to the accepting unit (para. 0166);
- a receiving unit that receives the print data from the server (para. 0167); and
- an outputting unit that prints out the received print data (para. 0159), whereby
- the server reads out the print data identified by the document ID from the print data storing unit, and sends the print data to the image forming apparatus in response to receiving the document ID from the transmitting unit of the image forming apparatus (para. 0202-0203);

the communications terminal includes:

- a document ID receiving unit that receives a document ID for identifying the print data from the server (e.g. print request information; para. 0137)

Aoki does not disclose the following limitations, however Rosen teaches the limitations:

the accounting control device includes:

- a deposit money storing unit that stores a certain amount of electronic money deposited in the communications terminal of the user (col. 4, lines 12-47);
- a transmitting unit that transmits a command requesting addition or subtraction of electronic money to the communications terminal (col. 4, lines 12-47); and
- an electronic money administering unit that alters the amount of electronic money stored in the deposit money storing unit in response to the command requesting addition or subtraction of electronic money sent from the transmitting unit (col. 4, lines 12-47), and

the communications terminal includes:

- a sending/receiving unit that communicates data with the accounting control device (col. 4, lines 12-47);
- a storing unit that stores a certain amount of electronic money therein (col. 4, lines 12-47), an electronic money information altering unit that alters the amount of electronic money stored in the storing unit therein in response to an instruction from the accounting control unit (col. 4, lines 12-47).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Rosen within Aoki for the

motivation of providing a secure electronic real-time purchase transaction between buyer and seller without third-party intervention (col. 2, lines 21-23).

Neither Aoki nor Rosen disclose or teach the limitation of a display which displays the amount of electronic money stored in the storing unit.

However, Kawan teaches that a cellular telephone with a smart card can be used as a transaction terminal. Kawan also teaches that the cellular telephone has a display and can be used to read data stored on a smart card to determine, for example, a value corresponding to an amount of funds existing in the user's account (col. 4, lines 7-64). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Kawan within Aoki for the motivation of providing a system for performing financial transactions which utilizes wireless, portable terminals (col. 1, lines 15-20).

As to claim 2, Aoki does not disclose the following limitations, however Rosen teaches the limitations:

the communications terminal includes:

- a password storing unit that stores a password used in permitting alteration of the amount of electronic money stored in the storing unit of the communications terminal (col. 11, lines 38-42);
- a password input unit that allows the user to input an arbitrary digit or digits indicative of a password by external manipulation (col. 11, lines 38-42);

- an authenticating unit that judges whether the password inputted by the password input unit coincides with the password stored in the password storing unit (col. 11, lines 38-42); and
- a controlling unit that controls the electronic money information altering unit to alter the data indicative of the amount of electronic money stored in the storing unit of the communications terminal in response to the instruction sent from the accounting control unit if the authenticating unit judges that the password inputted by the password input unit coincides with the password stored in the password storing unit (col. 4, lines 12-47).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Rosen within Aoki for the motivation of providing a secure electronic real-time purchase transaction between buyer and seller without third-party intervention (col. 2, lines 21-23).

As to claim 5, Aoki discloses the system according to Claim 4, wherein the server includes thumbnail image data generating unit that generates thumbnail image data representing the print data stored in the print data storing unit, and the server is operative to allow the data sending/receiving unit to send the document ID for identifying the print data, and the thumbnail image data to the communications terminal (para. 0198-0199).

As to claims 6 and 7, Aoki does not disclose the system of claims 4 and 5, wherein the data sending/receiving unit of the server is operative to communicate various data with the communications terminal or the accounting control device, and to send the print data to the image forming apparatus in response to receiving, from the communications terminal or from the accounting control device, a notification notifying that a certain amount of electronic money equivalent to the price of the print data is subtracted in the communications terminal.

However, Rosen teaches a system where the terminal and server are both notified of a successful completion of payment (see Abstract). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Rosen within Aoki for the motivation of providing a secure transaction environment for both the buyer and the seller (col. 1, lines 17-24).

As to claims 8 and 9, Aoki does not disclose the system according to claims 4 and 5, wherein the data sending/receiving unit of the server is operative to communicate various data with the communications terminal or the accounting control device, and to send the print data to the image forming apparatus in response to receiving, from the communications terminal or from the accounting control device, information relating to the electronic money stored in the storing unit of the communications terminal, and based on a judgment that the price of the print data whose transmission has been requested from the communications terminal does not exceed the amount of electronic money stored in the storing unit.

However, Rosen teaches a system that checks if the money module (i.e. the communications terminal) has sufficient funds to cover the payment (col. 21, lines 50-53).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Rosen within Aoki for the motivation of providing a secure transaction environment for both the buyer and the seller (col. 1, lines 17-24).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571) 272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Stefanos Karmis

GREGORY JOHNSON
Examiner
Art Unit 3691

